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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CARLSON, JEFFREY D

ART UNIT PAPER NUMBER

3622

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/733,891

Applicant(s)

KADDECHE ET AL.

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is responsive to the paper(s) filed 6/29/06.

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification must fully support the claim language, including the claims which lack enablement as detailed below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112.

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- Claims 15-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 15 states that mining of the lookup table is performed. The claim continues to describe that the mining is done in order “to resolve...and to extract...by constructing.” This future-tense mention of to resolve and to extract by constructing is not taken at this time to positively require these actions (the claim step at hand merely

includes a positive step of “mining” or what the examiner takes to be “inspecting” the data). However, even if the constructing a polygon were to be argued as a positive limitation given the present claim language, there is insufficient disclosure in the specification to enable one of ordinary skill to carry out this resolving/extracting/constructing. The disclosure merely states that:

- A] “A lookup table can be constructed to derive a polygon based on all the physical addresses of the users.” [pg 6 lines 26+]
- B] “In order to resolve multiple entries for the same IP address, the area polygon representing all possible locations for that IP can be built.” [pg 6 lines 26+]
- C] “Resolve multiple entries for the same IP address by building an area polygon representing all the possible locations for that IP.” [pg 10 lines 1+]

It is unclear how the polygon is built. Is one actually drawn on paper or rendered visually on a screen? Or is some sort of calculation done which only mathematically represents a polygon? How does proceed after construction of the polygon in order to resolve the multiple entries to a single entry?

- Claim 19, it is unclear how the confidence level is obtained and how it is used in the table.

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- Claim 27, there is no original support for sending an email to a 3rd party.
While there is support for email communication (original claim 4), neither the recipient nor sender is particularly specified.
- Claim 21, the “unique string” cannot be found in the original disclosure. It is unclear what this represents. IP? Cookie? Something else?

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. **Claims 22, 23 are rejected under 35 U.S.C. 102(a) as being anticipated by Merriman et al (US5948061).**

Regarding claim 22, Merriman et al teaches customized advertising for web site visitors. An ad server process (19) runs on a server that is connected to the Internet and to the other machines involved [fig 1]. Visiting users are identified by IP address [5:15-16] and these identified users are presented with a generic messaging space filled by an ad chosen for them based on their profile (which includes their location) [2:19-30, 3:5-23, 4:44-55, f4:65 to 5:8, fig 3A]. The location for a new user requesting a web page and its associated generic message space (banner space) is not immediately known by the system, yet the system determines the user's IP address [5:38-39] and

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subsequently will derive the user's profile [5:40-42] by querying Internet Whois databases [7:45-55] in order to determine the address and therefore the geographic location and the time zone to be associated with the user [7:56 to 8:1]. The user location is now known and an advertisement will be delivered to the user based upon his profile which now includes location information. Either one of the user profile database or the network lookup-tools (i.e. a Whois database) can be taken to represent a database correlating IP addresses with geographical information used to approximate or determine the user's location to server as a basis for location-based targeted advertising. Regarding the language concerning the geographically oriented applets, the claim language sets forth a step of "providing a database" that correlates IP and location. This is taken to require providing a database schema arranged to store the information as well the step of storing the data in the database itself. Describing the data stored in the database by mentioning *how* the data was originally collected is not taken to represent a positive limitation for this step of "providing a database". The steps(s) of providing a database (design and data storage) are performed the same regardless of how the data is collected or authored.

Regarding claim 23, Merriman et al teaches that upon clicking an advertising banner, the user is then connected to the advertiser's website [3:18-23]. The displayed content of such a website delivered to the user who has "clicked through" the banner is taken to read on an electronic version of a document.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 15, 16, 18, 20-22, 24, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parekh et al (US6757740) in view of Naidoo (US6629136).**

Regarding claims 15, 18, 22, 24, applicant's claimed invention essentially consists of two parts: 1) the collection of user-submitted location information and creation of an IP vs. location database and 2) using such a database to provide geographically targeted ads. For ease of understanding, examiner will discuss the 2nd part first, then the 1st part as it relates to the applied art. Parekh et al teaches the determination of a user's location and delivery of geographically targeted advertising to the user [3:32-36]. This is accomplished by a central computer system (50) providing a database which maps IP addresses to geographic locations. Other websites' servers desiring to geographically target advertisers to their visitors contact this server via the Internet with a visitor's IP address and request geographic location information for that IP-identified user which is then used to deliver customized content to the visitor [figure 5, 11:30-67]. When a user whose IP address is already in the database returns to a website using such a system, the database is searched for the matching IP address, a location is identified and an appropriate geographically targeted ad is selected for the returning visitor. This is taken to read on applicant's second part of claim 1 in that such

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a visitor's location is not known to the web server, but perhaps to the central host computer (50). Further the locations stored by Parekh et al represent guesses and even if guesses are stored for user's IP it could be said that their location is not truly "known". Further still, if the visitor is new (his IP is not in the database), Parekh et al will associate his IP with other similar IP addresses that are in the database and consider this to be a sufficient match and the noted location is used for targeting the ad to this "new" user [10:36-49]. Parekh et al teaches that visitors without any stored location information can be associated with location information through the use of network analysis tools such as ping, traceroute, whois, etc [4:54-61]. Parekh et al states that the invention is not limited to these tools and that any system or method can be used to determine user's location [4:62-68]. Another example offered by Parekh et al is that users can submit their own location information for use in the IP vs. location database [12:44-50]. Because any online process to collect information is taken to be an "applet" (as a mini application per se), Parekh et al's disclosure to collect user-submitted information is taken to read on the steps of collecting user-submitted geographic information through activated geographic applets. Further, Official Notice has been taken without seasonable challenge by applicant that applets such as java-based applets are known mechanisms to request information from a user. It would have been obvious to one of ordinary skill at the time of the invention to have used any well known information request mechanism including a java applet in order to request and receive the user's specified address. Parekh et al does not explicitly teach the use of geocoding to transform a geographic attribute to latitude and longitude coordinates.

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Naidoo also teaches a system where users receive location-based advertising based upon their stored location information [abstract]. Users in Naidoo submit their address which is geocoded into a spatial coordinate system such as lat/long [2:48-60, 8:32-45]. It would have been obvious to one of ordinary skill at the time of the invention to have geocoded into lat/long coordinates the location information provided by users of Parekh et al so that user's locations can be accurately targeted with high precision. Parekh et al teaches that multiple entry conflicts can be analyzed and resolved [12:44-53, 11:1-13] which is taken to read on the positive step of "mining" as well as the non-limiting reference to constructing a polygon as best understood.

Regarding claim 16, providing location-based advertising is taken to inherently include advertising for an entity located or servicing locations within a predefined distance from the defined user location. Inclusion of a banner ad is taken to meet the connection to a third party web server. Further, Naidoo teaches that promotional notices, links to websites and telephone directory information may be delivered all of which correspond to the geographic area [3:51-58].

Regarding claim 20, the determination of a user's location and the subsequent selection of an ad for a nearby advertiser or vendor is taken to inherently "derive...demographic information" for the user. The user is determined to be located within the location of the advertiser/vendor. Location is taken to be demographic information.

Regarding claim 21, the users are identified by their IP address (i.e. 130.207.47.1) which is taken to be a unique string.

Regarding claim 23, applicant admits the known use of Internet advertising whereby a user presented with an online ad clicks the ad in order to link to a page where they can learn more about the product or purchase the product [spec page 1 lines 21-25]. It would have been obvious to one of ordinary skill at the time of the invention to have provided the ads of Parekh et al as clickable ads so that users may learn more and/or purchase the product online. The web document the user see after he clicks is taken to read at least on a "electronic version of a document."

Regarding claim 25, interpolation and extrapolation are well known methods for determining a value when nearby data points are known. Parekh et al teaches interpolation for the confidence value of an unknown location entry when such entry is surrounded by neighboring location entries. It would have been obvious to one of ordinary skill at the time of the invention to have used interpolation in order to define the location of an unknown IP address when similar IP addresses are however known. This provides a valuable method taught by Parekh et al for gathering data about an unknown entry.

7. Claims 17, 19, 23, 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parekh et al in view of Naidoo and Merriman et al.

Regarding claim 17, Parekh et al does not appear to describe subsequent communications between the user and the advertising/advertiser. Merriman et al teaches that upon clicking an advertising banner, the user is then connected to the

advertiser's website [3:18-23]. This is taken to provide a secondary message to the user.

Regarding claim 19, Merriman et al teaches a user targeting profile to include IP, address, location, time zone, etc [fig 3A]. Parekh et al teaches the use of city, county, regional and state geographic parameters to derive the users location-based profile. It would have been obvious to one of ordinary skill at the time of the invention to have zipcode as a similar geographic parameter. Further, Naidoo teaches that zip codes are known to be used for targeting to location [2:7-10] and it would have been obvious to one of ordinary skill at the time of the invention to have used zip codes in order to profile user location. Lastly, Naidoo teaches that location based targeting may be based upon a desired geographic level such as a census tract, neighborhood, subdivision, school district, trade area, etc [3:34-37] and it would have been obvious to one of ordinary skill at the time of the invention to have also used zipcode as a similar political boundary. Naidoo teaches that the desired geographic level of the customized information may be dynamically based upon a desired geographic level responsive to a user's request for localized content or automatically based upon the subject matter of the user's requested content [3:27-41] and that the user may request content by using a zoomable map [6:41-55]. It would have been obvious to one of ordinary skill at the time of the invention to have determined (i.e. assumed) a user's location based upon the maps and zoom level (view extent) that the user requests. Lastly, Parekh et al teaches that confidence levels can be applied to the information stored in the user location profile [6:7-12, 25-48, 8:44-47].

Regarding claims 23, 27, Merriman et al teaches that upon clicking an advertising banner, the user is then connected to the advertiser's website [3:18-23]. The displayed content of such a website delivered to the user who has "clicked through" the banner is taken to read on an electronic version/message of a document.

8. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parekh et al in view of Naidoo and further in view of Eldering (US6324519).

Regarding claim 26, Parekh et al does not appear to teach bidding for advertising placement. Eldering however teaches the idea of advertisers bidding to place their ads responsive to announced ad opportunities in a real-time online environment [abstract]. It would have been obvious to one of ordinary skill at the time of the invention to have used a bidding system in order to fulfill the advertising selection described by Parekh et al in order to maximize advertising revenue.

Response to Arguments

9. Applicant argues that the art focuses on the server, not the users. This argument appears to be narrower than the current claim scope. However it is noted that Parekh et al indeed collects location information submitted by users and uses this as a basis for location-based targeted advertising.

10. Applicant argues that Merriman et al lacks an IP vs. location database. Both the user profile database and the Whois database are taken to provide such a feature.

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11. Applicant argues that Naidoo's geocoding is done to registration information and that his geocoding does not represent the true location of the users and that Naidoo will not work is the user accesses the network from different locations. It is noted that Naidoo is only used to modify Parekh et al in order to geocoded Parekh et al's location information with lat/long waypoints for higher precision.

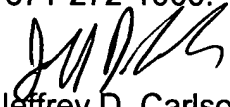
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc